

TRANSMITTAL OF APPEAL BRIEFDocket No.
VID-02202/29

In re Application of: Barry H. Schwab et al.

Application No.
09/900,827-Conf. #8990Filing Date
July 6, 2001Examiner
R. ChanGroup Art Unit
2618

Invention: PORTABLE COMMUNICATIONS DEVICE

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal
filed: December 6, 2007 .

The fee for filing this Appeal Brief is \$255.00 .☐

Large Entity

☒

Small Entity

☐

A petition for extension of time is also enclosed.

The fee for the extension of time is _____ .

☐

A check in the amount of _____ is enclosed.

☐

Charge the amount of the fee to Deposit Account No. _____ .
This sheet is submitted in duplicate.

☒

Payment by credit card.

☒

The Director is hereby authorized to charge any additional fees that may be required or
credit any overpayment to Deposit Account No. 07-1180 .
This sheet is submitted in duplicate.

/John G. Posa/

John G. Posa

Attorney Reg. No. : 37,424

GIFFORD, KRASS, SPRINKLE, ANDERSON &
CITKOWSKI, P.C.

2701 Troy Center Drive, Suite 330

Post Office Box 7021

Troy, Michigan 48007-7021

(734) 913-9300

Dated: February 6, 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Schwab et al

Serial No.: 09/900,827

Group No.: 2618

Filed: July 6, 2001

Examiner: R. Chan

For: PORTABLE COMMUNICATIONS DEVICE

APPELLANTS' APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Barry H. Schwab and John G. Posa, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 7 claims. Claims 1-2 and 4 have been canceled. Claims 3 and 5-7 are pending, rejected and under appeal. Claim 3 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

An after-final amendment was filed on October 8, 2007. This amendment has not been entered as stated in two Advisory Actions dated October 19, 2007 and December 13, 2007. Appellants do not understand why the amendment was not entered since the goal was to place two dependent claims (6

and 7) in independent form without any additional dependencies. This would not have changed the scope of the claims, would not have warranted a further search, and would have streamlined the issues on appeal.

V. Summary of Claimed Subject Matter

Independent claim 3 is directed to a method of improving the hands-free operation of a communications device having a speed-dial function. The method includes the steps of storing a plurality of telephone numbers in the device in a list of numbers to be dialed; entering an abbreviated command to sequence through the list to dial each stored number; and automatically deleting a number from the list after a call to that number has been completed. Claim 6 adds to claim 3 that the abbreviated command is manually entered, and claim 7 adds to claims 3 that the abbreviated command is spoken by a user. (Specification, page 3, lines 10-19)

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 6 and 7¹ under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,636,267 to Utsumi *et al.*

VII. Argument

A. The Rejection of Claims 6 and 7

Claims 6 and 7 were rejected under 35 USC §103(a) over Utsumi ('267) on the grounds that it would provide Utsumi "with a wide array of call entry sequences." However, this runs counter to the teachings of the reference. The whole point of Utsumi is automated call-list "cleaning." Forcing a user to manually enter an abbreviated command or speak an abbreviated command would slow down Utsumi's process and would therefore not be an obvious modification. According to the '267 Patent:

"A telephone number list to be cleaned is provided on a floppy disk recorded in a predetermined format. The floppy disk containing the telephone number list is set in the floppy disk drive 4 and a cleaning command is given by designating a list name through a keyboard 7. Then, *the CPU 1 reads out the designated telephone number list* from the

¹ Appellants are appealing only two dependent claims at this time. Should they be allowed, Appellants will draft them in independent form as intended with an after-final amendment, which the Examiner refused to enter.

floppy disk and stores in the memory 2. Thereafter, *the CPU 1 initiates execution of cleaning process shown in FIG. 2.*

"At first, respective telephone numbers are picked up from the telephone number list according to a predetermined order for transferring to the circuit control portion 9, and a call command is provided (step 100). By this action, call operation is performed by transmitting a dial signal of the telephone number to the public telephone network (step 101). Then, at step 102, waiting state is maintained for an appropriate period (corresponding to a time to actuate a local exchange). Thereafter, reaction of the line in response to the call is monitored by the signal discrimination circuit of the circuit control portion 9 through processes at step 103 and subsequent steps." ('267 Patent, 5:6-25, emphasis added)

Thus, after loading a floppy disk, the entire process of Utsumi is automated, with the CPU performing all of the steps. It does not make sense to interrupt this with a manual or spoken command. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Conclusion

For the arguments of record and the reasons set forth herein, Appellants believe that all pending claims are in condition for allowance, and Appellants seek the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: Feb. 6, 2008

John G. Posa
Reg. No. 37,424
Gifford, Krass, Sprinkle, Anderson &
Citkowski, P.C.
PO Box 7021
Troy, MI 48007-7021
(734) 913-9300

APPENDIX A

CLAIMS ON APPEAL

3. In a communications device having a speed-dial function, a method of improving hands-free operation, including the steps of:

storing a plurality of telephone numbers in the device in a list of numbers to be dialed;
entering an abbreviated command to sequence through the list to dial each stored number; and
automatically deleting a number from the list after a call to that number has been completed.

5. The method of claim 3, including the step of leaving a number on the list for later recall if the call to that number could not be completed at the time it was dialed.

6. The method of claim 3, wherein the abbreviated command is manually entered.

7. The method of claim 3, wherein the abbreviated command is spoken by a user.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.